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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/672,917	09/28/2000	Dennis R. Raffaelli	INL-00056	8566

7590 06/03/2004

Warn IP Law Office  
P.O. Box 70098  
Rochester Hills, MI 48307

EXAMINER
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OJINI, EZIAMARA ANTHONY

ART UNIT	PAPER NUMBER
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3723

DATE MAILED: 06/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/672,917

**Applicant(s)**

RAFFAELLI, DENNIS R.

**Examiner**

Anthony Ojini

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 3 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 3 states that the swarf clearing groove extends along a portion which is broader than the limitation in claim 1 which required the entire width.

Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**In claim 1**, lines 8,9, following the term "planar side" add **----portion-----**.

**Claim 3** states that the swarf clearing groove extends along a portion which is broader than the limitation in claim 1 which required the entire width.

**In claim 4**, the expression "entire length" is unclear what is meant by the "entire length".

If it is intended to be width, claim is redundant to claim 1.

**In claim 10**, lines 9,10, following the term "planar side" add **----portion-----**.

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**In claim 11, lines 1,2**, the expression "said swarf clearing groove extends along the entire length of the said cutting surface" is inaccurate and renders the scope of indefinite

**In claim 17, lines 10,11**, following the term "planar side" add ----**portion**-----.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7,10-14, 17 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Held (3,711,999) in view of Langlois et al. (4,978,254).

**With respect to claims 1-4,10 and 11**, Held discloses a rotary edging wheel comprising a hub portion (see fig. 1); an outer circumferential abrading surface (16) having a width and abrasive grit attached thereto, and a circumferential groove therein (22); a radially extending planar side portion (18); a plurality of grooves (12f) extending at an angle at least across the entire length of the abrading surface (see fig. 9) and opening into the planar surface (see fig. 13).

Held fails to disclose, wherein surface is operable for edge finishing of an optical lens.

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Langlois et al. disclose edge finishing of an optical lens (see back of the invention).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Held with **grinding machine** for edge finishing of an optical lens in view of Langlois so as to inherent properties of transparency and breaking strength.

**With respect to claims 5-7,12-14**, Held fails to disclose optimum ranges as claimed by the applicant.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide device of Held with the optimum ranges as claimed by the applicant **so as to assist in cleaning swarfs**, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

**With respect to claim 20**, Held fails to disclose optimum ranges as claimed by the applicant.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide device of Held with the optimum ranges as claimed by the applicant **so as to provide a precision grinding applications**, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

**With respect to claim 17**, Held is discussed above in claims 1 and 10 except the optimum range as claimed by the applicant.

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It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide device of Held with the optimum range as claimed by the applicant **so as to assist in cleaning swarfs**, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Claims 8,9,15,16,18,19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Held (3,711,999) in view of Hagan (5,997,597).

**With respect to claims 8,15,18**, Held fails to disclose the abrasive grit is attached to the wheel by brazing.

Hagan discloses an abrasive grits (26) that is grazed onto a cutting wheel (see abstract & fig. 7).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide device of Held with an abrasive grits (26) that is grazed onto a cutting wheel in view of Hagan so as to attenuate the texture of the cutting surface of the wheel.

**With respect to claims 9,16,19**, Held fails to disclose the abrasive grit is a diamond hardness grit. Hagan discloses the abrasive grit is a diamond hardness grit (see col. 4, lines 10-11). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide device of Held with an abrasive grits that is diamond hardness grit in view of Hagan so as to cut relatively hard material such as metal, concrete, stone, ceramic.

***Response to Amendment***

Applicant's arguments filed 6/9/03 have been fully considered but they are not persuasive.

**Applicant argues** that U.S Patent No. 3,711,999 to Held "only teaches that the so-called notch (12f) is for cooling purposes, and is completely silent regarding swarf removal. In fact, Held does not disclose any swarf-clearing grooves in an outer cutting surface of a grinding wheel". However, Held discloses the concept of a rotary edging wheel for abrading comprising a plurality of grooves (12f) extending at an angle at least across the entire length of the abrading surface that is equivalent in structure with applicant's structure which would inherently assist in cleaning swarfs.

**Applicant argues** that "the notches disclosed by Held are merely for air-cooling purposes and not for material removal purposes". However, Held device would inherently assist in cleaning swarfs.

**Applicant argues** that "Held is also completely silent as to whether the circumferential cutting surface is operable to edge finish an optical lens". However, Langlois et al. disclose concept of edge finishing of an optical lens.

**Applicant argues** that U.S Patent No. 5,997,597 to Hagan "does not disclose or suggest, among other things, a rotary edging wheel that is operable to edge finish an optical lens". However, Hagan discloses concept of an abrasive grits (26) that is grazed onto a cutting wheel.

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***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Ojini whose telephone number is 703 305 3768. The examiner can normally be reached on 7 to 4 Tuesday-Friday with every other Monday off.

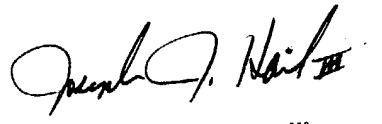
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on 703 308 2687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AO  
May 17, 2004



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